

REMARKS

In the Office Action, the Examiner rejected claims 1-27 and 31-37 under 35 USC § 103(a). These rejections are fully traversed below.

Claims 1, 11, 13, 20, 25, 34, 35 and 36 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention, and new claims 38-49 have been added to the application. Support for these changes may be found throughout the specification and figures. No new matter has been added. Claims 24 and 37 cancelled without prejudice or disclaimer. Claims 1-23, 25-27, 31-36 and 38-49 are now pending in the application.

Reconsideration of the application is respectfully requested based on the following remarks.

The 35 U.S.C. § 103 Rejection

Claims 11, 12 and 31 stand rejected under 35 U.S.C. § 103(a) as being allegedly anticipated by Gardos et al. (USP 7,251,826); claims 1-8, 10, 13-21, 23-25, 34 and 37 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gardos et al. in view of Meunier et al. (USP 6,681,369); claim 32 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gardos et al. in view of Meunier et al. and further in view of George (US Patent No. 5,832,478); and claims 9, 22, 26, 27, 33, 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gardos et al. in view of Meunier et al. and further in view of Hollenbeck (US Pub. 2005/0102354). These rejections are respectfully traversed below.

Applicant respectfully submits that Gardos, along or in combination with any of the secondary references, fails to teach or suggest the claimed invention. More specifically, claim 1 pertains to a computer-implemented method for monitoring domain name registrations. The method of claim 1 recites:

- (a) receiving a request to monitor a name, wherein the request to monitor is to identify at least one domain name that is similar to the name to be monitored and wherein the at least one similar domain name matches at least one domain variation of the name to be monitored;
- (b) determining a domain space about the name to be monitored,

the domain space including the at least one domain variation of the name to be monitored;

(c) searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored;

(d) notifying the requestor of the identified one or more registrations of domain names that have been identified by said searching (c) as matching the at least one variation of the name being monitored; and

(e) sending warning messages to one or more registrants, other than the requestor, of the identified one or more registrations indicating that the identified one or more registrations are substantially similar to the name being monitored, wherein the warning message sent to each of the one or more registrants includes a notice indicating that the corresponding registrant has registered an offending registration.

As for element (a), “receiving a request to monitor a name, wherein the request to monitor is to identify at least one domain name that is similar to the name to be monitored and wherein the at least one similar domain name matches at least one domain variation of the name to be monitored....” In general, Gardos describes a system and method for managing existing domains. Gardos merely offers management of existing domains, not monitoring for domain name registrations. Gardos does not teach monitoring a name to identify at least one domain name that is similar to the name to be monitored. Gardos thus fails to teach or suggest element (a) of claim 1.

As for element (b), “determining a domain space about the name to be monitored, the domain space including the at least one domain variation of the name to be monitored”, the Examiner points to Figs. 5 and 6. Fig. 5 merely allows a user to assign aliases to a particular domain [victoriakarol.com], and Fig. 6 merely allows the user to specify mail servers for this particular domain. See Gardos, col. 7, line 60 to col. 8, line 46. Gardos thus fails to teach or suggest element (b) of claim 1.

As for element (c), “searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored”, the Examiner points to Figs. 5, 6, 7, 9 and 10. The Examiner further asserts that “figures 5 and 6, ISP Manager allows entering a search (Figure 2) which results in retrieval of plurality of variations of domain name

registrations that can be monitored.” Applications respectfully disagree. The Examiner is simply picking and choosing portions of the prior art reference for a convenient rejection. As stated in Gardos, Figure 6 simply illustrates “the domain manager retrieves the aliases associated with a domain name to display the aliases and the domain names to which the aliases resolve. … If no aliases have been established for the domain name, the www and ftp aliases are set to default settings.” (Col. 7, lines 64-67 and Col. 8, lines 9-10. Contrary to the assertions alleged in the Office Action, Gardos does not teach searching a database to retrieve a plurality of variations of domain name registrations. Rather, Gardos teaches the use of default settings, which does not involve “searching a database of domain name registrations” as recited in claim 1. As such, Gardos does not teach or suggest “searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored” as recited in claim 1.

As for element (d), “notifying the requestor of the identified one or more registrations of domain names that have been identified by said searching (c) as matching the at least one variation of the name being monitored”, the Examiner points to Figs. 5-10 and states that “notifying requestor of one or more registrations could be interpreted as displaying the result in response to the conducted search.” The Examiner is improperly reading the prior art reference for a convenient rejection. While Figs. 5-10 of Gardos can display information concerned with management of a domain name, nothing in Gardos teaches or suggest anything about notifying a requestor of one or more registrations that are identified by the searching of element (c) for monitoring to identify one or more registrations of domain names that match the at least one variation of the name being monitored. Furthermore, Gardos does not teach or suggest “notifying the requestor of the identified domain names that have been identified by the searching (c)” as recited in claim 1.

As for element (e), “sending warning messages to one or more registrants, other than the requestor, of the identified one or more registrations indicating that the identified one or more registrations are substantially similar to the name being monitored, wherein the warning message sent to each of the one or more registrants includes a notice indicating that the corresponding registrant has registered an

offending registration”, it should be noted that Gardos does not teach or suggest sending a warning message to a registrant that has registered an offending registration as recited in claim 1.

Accordingly, it is submitted that Gardos fails to teach or suggest any of elements (a) through (e) of claim 1. Even if Meunier et al. were to be combined with Gardos, the combination of references would still fail to teach or suggest any of the elements (a) through (e) of claim 1.

Accordingly, it is submitted that claim 1 is patentably distinct from Gardos and Meunier et al.

Claim 11 pertains to a method for monitoring domain name registrations. The method recites:

- (a) receiving a request to monitor a name on behalf of a requestor;
- (b) searching a database of domain name registrations to identify one or more registrations of domain names that match the name being monitored;
- (c) notifying the requestor of the identified one or more registrations; and
- (d) sending warning messages to one or more registrants, other than the requestor, of the identified one or more registrations indicating that the identified one or more registrations match the name being monitored, wherein the warning message sent to each of the one or more registrants includes a notice indicating that the corresponding registrant has registered an offending registration.

Gardos fail to teach or suggest elements (a) through (d) of claim 11 for reasons similar to those noted above with respect to claim 1.

Additionally, the Examiner has previously equated the “warning messages to one or more registrants” to the “authorization request from the administrative contact for the domain name” illustrated in Fig. 4 of Gardos. Applicants respectfully disagree. Nowhere does Gardos teach or suggest notifying the offending registrants. As stated previously, Gardos mentions an authorization email being sent; however, an authorization email such as used in Gardos is not a warning message to registrants of those one or more registrations that have been identified by the searching as matching

the name being monitored. The email is sent to the client and not the offending “registrants of the identified one or more registrations” as recited in claim 11.

Accordingly, it is submitted that claim 11 is patentably distinct from Gardos and Meunier et al.

Claims 13 and 20 also pertain to method for monitoring domain name registrations. Elements (a) through (d) of claims 13 and 20 are similar to elements (a) through (d) of claim 11. Hence, for at least the associated reasons noted above with respect to claim 11, it is submitted that claims 13 and 20 are patentably distinct from Gardos and Meunier et al.

Hollenbeck et al. also does not overcome the various deficiencies of Gardos and Meunier et al.

Based on the foregoing, it is submitted that claims 1, 11, 13 and 20 are patentably distinct from Gardos, Meunier et al. and/or Hollenbeck et al. In addition, it is submitted that claims 2-10, 12, 14-19, 21-23, 25-27 and 31-36 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Gardos, Meunier et al. and/or Hollenbeck et al.

Thus, it is respectfully requested that the Examiner withdraw the rejection of claims 1-27 and 31-37 under 35 USC § 103(a).

Conclusion

It is submitted that claims 1-23, 25-27 and 31-36 (as well as new claims 38-49) are patentable distinct from the cited references, alone or in any combination. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-0388 (Order No. RLC1G000).

Respectfully submitted,

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